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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,891	08/20/2003	Steven M.H. Wallman	1061/6	6367

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EXAMINER

OSBORNE, MATTHEW C

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/644,891

Applicant(s)

WALLMAN, STEVEN M.H.

Examiner

Matthew Osborne

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20040818
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is the first office action on the merits for Application 10/644891.

Claims 1-7 and 28-34 have been elected and examined.

Claims 8-27 and 35-54 are drawn to non-elected claims and are withdrawn accordingly.

Election/Restrictions

1. Claims 8-27 and 35-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the telephonic reply of 4/20/2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanders (2001/0042036).

4. Re Claims 1-2 and 7, Sanders discloses a "method and system for investing in customizable investment products," comprising:

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- [Claim 1] determining an amount of a desired portfolio of assets/rights/liabilities that must be purchased on margin so that a riskiness characteristic of a resulting portfolio matches a user specified riskiness characteristic; and (see at least Figure 1, from at least "select terms" through at least "best price offer" in at least CybicBulls/Bears embodiment)
- purchasing the determined amount of the desired portfolio of assets/rights/liabilities on margin. (see at least Figure 1, "Order is executed")
- [Claim 2] selecting by a user a riskiness characteristic of a desired portfolio of assets/rights/liabilities. (see at least Paragraph 53)
- [Claim 7] providing a predetermined portfolio of assets, rights or liabilities; (see at least Paragraph 53)
- receiving a user specified riskiness characteristic and a user's investment funds; (see at least Paragraph 53)
- determining an amount of the predetermined portfolio of assets, rights or liabilities that must be purchased on margin so that a resulting riskiness characteristic of a resulting portfolio matches the user specified riskiness characteristic; and (see at least Figure 1, from at least "select terms" through at least "best price offer" in at least CybicBulls/Bears embodiment)
- purchasing the determined amount of the predetermined portfolio of assets, rights or liabilities on margin along with an amount of the predetermined portfolio of assets, rights or liabilities purchased with the user's investment funds. (see at

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least Figure 1, "Order is executed" and accompanying explanation in specification, Paragraphs 53-55)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders ('036) in view of Horner et al. (2003/0009409).

7. Re Claims 3 and 6, Sanders discloses all of the limitations of parent claim 2, *supra*. Sanders further discloses where [Claim 6] the user interacts by entering a numerical value (see at least Figure 5, "customer picks a leverage factor between 5 and 20"). Sanders does not specifically disclose [Claim 3] *interacting with a graphical user interface*. However, Horner discloses "systems and methods for providing risk/return measures for securities lending programs" which includes interaction with a GUI (see at least Figures 4-7). Since both Sanders and Horner relate to risk tolerance calculation, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the GUI of Horner into the method and system of Sanders in order to provide improved usability.

8. Claims 28-30 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders ('036) in view of Horner et al. ('409).

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9. Re Claims 28-30 and 33-34, Sanders discloses all of the limitations in the corresponding method claims 1-2 and 7, *supra*. Sanders further discloses where [Claim 33] the user interacts by entering a numerical value (see at least Figure 5, "customer picks a leverage factor between 5 and 20"). Sanders does not specifically disclose [Claim 28] *a computer including a display and a user interface*, [Claim 30] *interacting with a graphical user interface*, and [Claim 34] *a processor*. However, Horner discloses "systems and methods for providing risk/return measures for securities lending programs" which include a PC (see at least Paragraph 49) and interaction with a GUI (see at least Figures 4-7). Since both Sanders and Horner relate to risk tolerance calculation, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the GUI of Horner into the method and system of Sanders in order to provide improved usability.

10. Claim 4 and 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders ('036) in view of Horner ('409) as applied to claims 3 and 30 above, and further in view of Nolan (5,754,873).

11. Sanders in view of Horner does not specifically disclose a *slider bar*. However, Nolan discloses a graphical user interface for scaling a block of text which "scaling preference can be selected using a graphical control, such as a slider bar or dial" (see Column 9, Lines 58-67). Since both Sanders in view of Horner and Nolan relate to graphical user interfaces, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the slider bar interface element of Nolan into the

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investment system and method of Sanders in view of Horner in order to provide improved usability.

12. Claim 5 and 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders ('036) in view of Horner ('409) as applied to claims 3 and 30 above, and further in view of Marks et al. (2001/0053944).

13. Sanders in view of Horner does not specifically disclose an *arrow on a dial*. However, Marks discloses a graphical user interface for navigating internet audio which includes dials with arrows on them (see at least Figure 1). Since both Sanders in view of Horner and Marks relate to graphical user interfaces, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the dials with arrows interface elements of Marks into the investment system and method of Sanders in view of Horner in order to provide improved usability.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shepherd (5,970,479) discloses "methods and apparatus relating to the formulation and trading of risk management contracts."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Osborne
Examiner
AU 3694

MS


ELLA COLBERT
PRIMARY EXAMINER